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Appl. No.:10/813,331
Atty. Dkt. No.:10031531-1

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow claims 1, 2, 4-16 and 28, the only claims pending and currently under examination in this application.

Claim Rejections - 35 USC § 103

Claims 1, 2, 4-15 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US Patent No. 5,186,824, issued February 16, 1993) in view of Schleifer (A) (US Patent No. 6,077,674, issued June 20, 2000) or Schleifer (B) (U.S. Patent No. 6,309,828, issued October 30, 2001).

In making this rejection, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the polymers synthesized by Anderson et al to the further step of addressable array fabrication taught by Schleifer (A) or Schleifer (B) (addressable immobilization of pre-synthesized polymers) and therefore arrive at the claimed invention.

The Examiner's rejection is based on the assumption that the claims read on a method in which polymers are presynthesized and then deposited at specific locations to produce an addressable array.

The Applicants respectfully disagree with the Examiner's interpretation of the claims. The subject claims include the step of:

"(e) reiterating steps (a) to (d) [a-contacting blocked monomers, b-contacting with oxidation fluid, c-contacting with deblocking fluid, d-removing deblocking fluid] at least once to produce said addressable array of at least two different nucleic acid ligands".

As such, the claims are directed to an in situ fabrication process in which an addressable array is produced by synthesizing nucleic acid ligands directly on the surface of a solid support in manner that sequentially adds the monomeric units one at time.

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Anderson et al does not teach or suggest the *in situ* production of an addressable array of at least two nucleic acid polymeric ligands as claimed. Nor does the Examiner allege that Anderson et al teaches or suggests the claimed *in situ* process. Accordingly, Anderson is fundamentally deficient in failing to teach or suggest an *in situ* fabrication process as claimed.

Since Schleifer (A) and Schleifer (B) were cited by the Examiner solely for the purpose of an alleged teaching of making an addressable array by depositing premade polymers onto a surface of a support, these supplemental references fail to make up for the fundamental teachings in the primary reference.

In fact, because they teach one to deposit premade polymers onto a surface, they in fact teach away from producing the polymers on the surface *in situ*.

As such, Claims 1, 2, 4-15 and 28 are not obvious under 35 U.S.C. 103(a) over Anderson et al (US Patent No. 5,186,824, issued 16 February 1993) in view of Schleifer (A) (US Patent No. 6,077,674, issued 20 June 2000) or Schleifer (B) (US Patent No. 6,309,828, issued 30 October 2001) and this rejection should be withdrawn.

Claim 16 was rejected under 25 U.S.C. 103(a) as being unpatentable over Anderson et al, Schleifer (A), Schleifer (B) and further in view of Blanchard (US Patent No. 6,384,210, issued May 7, 2002).

In making this rejection, the Examiner alleges that the primary references teach all of the elements of the claimed invention, but for the element of a pulse-jet synthesis, for which element the Examiner looks to Blanchard. However, as reviewed above, Anderson et al in view of Schleifer (A) or Schleifer (B) fail to teach or suggest an *in situ* method of producing an addressable array of at least two different nucleic acid ligands as claimed. Since Blanchard was cited solely for the pulse-jet element, Blanchard fails to make up for the deficiency between Anderson et

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al in view of Schleifer (A) and Schleifer (B) and the invention in the present case. As such, Claim 16 is not obvious under 35 U.S.C. § 103 (a) over Anderson et al, Schleifer (A), Schleifer (B) and further in view of Blanchard and this rejection should be withdrawn.

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CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: July 30, 2007

By: 

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